

In each of claim 14 line 3 and claim 21 line 3 36 please insert --, 1-phenacyl-3,5-dicarboxypyridinium bromide-- before “(AP-5)”.

### REMARKS

Reconsideration of the above-identified patent application in view of the foregoing amendment and following remarks is respectfully requested. Claim 1 was amended to add an anion, as requested by the Examiner. All of the examples of compounds throughout the specification have an anion and the compound is disclosed as a salt. In two instances in the specification and in the Markush groups of claims 14 and 21 a clerical error has been fixed to show that the compound named “AP-5” and also called “PICVA-13” on page 36 of the specification is 1-phenacyl-3,5-dicarboxypyridinium bromide and not the 2,5 derivative. Support for this preferred embodiment correction is found in the specification, particularly on page 5 lines 31 (“Preferably, R and R<sub>1</sub> are meta to each other and to the heteroatom.”) and page 5 lines 31-32 (“Preferably, R is COOH. Preferably, R<sub>1</sub> is COOH.”). No new matter has been added. No new search is required. Entry of the foregoing amendment is respectfully requested. Claims 1, 2 and 5-21 are pending and claims 2 and 6-21 are free of prior art rejections.

#### 35 U.S.C. §112 Rejection

Claims 1, 6 and 7 were rejected under 35 U.S.C. §112 second paragraph as indefinite. Claim 1 was rejected as lacking a citation to an anion. Claim 1 was amended according to the Examiner’s suggestion to add an anion. Thus, the rejection of claim 1 has been obviated.

In response to the Examiner’s inquiry, the amendment to claim 1 made in Amendment A limits claim 1 such as R or R<sub>1</sub> must be COOH. Certainly both R and R<sub>1</sub> can be COOH as provided in the claim.

#### 35 U.S.C. §103 Rejection

Claims 1 and 5 were rejected under 35 U.S.C. §103(a) as unpatentable over Gubin. The Examiner has again picked out the compound N-phenylacetyl 2-methyl 4-ethoxycarbonyl pyridinium bromide in Gubin and alleges that the claimed acid is obvious over the ester “exemplified in the prior art.” Applicants traverse this rejection because the ester in Gubin does not form the claimed acid.

The issue of whether an acid is obvious over an ester, that is whether an ester cleaves so easily that Gubin actually possessed the acid, is and has always been moot. The Examiner’s rejection is based first on the allegation that the compound (N-phenylacetyl 2-methyl 4-ethoxycarbonyl pyridinium bromide) is an ester that forms an acid within claim 5 wherein R<sub>2</sub> and R<sub>3</sub> are both hydrogen. However, the claimed compound has a required N-(2-phenyl-2-oxoethyl)

moiety. The prior art compound in Gubin has a required N-phenylacetyl moiety. There is a significant chemical difference (much more than ester or corresponding COOH organic acid) between the compound of claims 1 and 5 and the compound illustrated by the Examiner in Gubin. Particularly, the 2-oxo group in between the rings is a required moiety of the claimed invention. This oxo group is missing in Gubin. Therefore, the prior art compound does not disclose even an ester that might be cleaved (under an undisclosed environment) to form a claimed acid salt.

Although not necessary in view of the fact that Gubin does not disclose even “related” or “corresponding” compounds, the allegation of a footnote in an old decision (*In re Schaub*) does not create a general rule that all esters disclose or suggest their corresponding acids. The issue is one of “structural similarity” under 35 U.S.C. §103. If the Examiner is alleging *prima facie* obviousness, the Examiner is respectfully requested to review the specification where the claimed compounds were shown to inhibit 3-aminopropanal-mediated tissue damage from ischemia. This is to be contrasted with Gubin where the only data in Gubin relates to a test for hypertension (blood pressure). Therefore, the present invention is not an obvious variant or any variant of Gubin as the utility shown in the specification (and the allowable method claims) is different from the activity shown for the different Gubin compounds.

There cannot be a rule set forth for chemical cases that esters render acids obvious (“And in any event, this court has previously stated that generalization is to be avoided insofar as specific structures are alleged to be *prima facie* obvious one from the other. *In re Grabiak*, 769 F.2d 729, 731, 226 USPQ 870, 872 (Fed. Cir. 1985).” *In re Jones* 21 USPQ2d 1941, 1943 (Fed. Cir. 1992)). The Examiner’s contention of a general rule of law regarding structural similarity is just plain wrong.

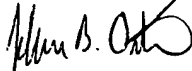
In addition, there is precedent that acids do not render an ethyl ester obvious (*In re Hoch*, 166 USPQ 406 (CCPA 1970)). In addition, the Examiner’s citation of *In re Schaub* does not support the proposition of any general rule or a decision that an ester renders a corresponding acid obvious<sup>1</sup>. In fact, **the citation was to a footnote referencing an argument that was not decided in the opinion**. This alleged “support” or “precedent” from the Examiner does not even rise to the level of dicta. Therefore, even though it is moot to the facts of the present (*i.e.*, the structural differences between the Gubin compound and the different moieties of the claimed compounds), the Examiner’s allegation of an ester rendering obvious an acid is wrong on the law. Accordingly, withdrawal of this rejection is respectfully requested.

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<sup>1</sup> It should be noted that the claimed compound and Gubin show that the claimed acid compounds are **NOT** the corresponding structures from the ester shown in Gubin.

In summary, applicants respectfully request withdrawal of both rejections and allowance of pending claims 1, 2, and 5-21.

Respectfully submitted,



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